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09/903,717	07/13/2001	Anders Onshage	032927-012	9292

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EXAMINER

CHOW, MING

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 07/21/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/903,717

Applicant(s)

ONSHAGE ET AL.

Examiner

Ming Chow

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 2645

1. Applicant's Petition To Withdraw Finality, see paper 8, filed on 7-3-03, with respect to the rejection(s) of claim(s) 4 under Walker et al have been fully considered and is persuasive. Therefore, the final rejection of the last Office Action (paper 7) has been withdrawn. However, upon further consideration of the After Final Amendment (paper 9), a new ground(s) of rejection is made in view of and necessitated by the After Final Amendment (paper 9).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 2645

2. Claims 1-3, 5-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al (US: 6529602).

Regarding claims 1, 5, 8 and 14, Walker et al teach a method and apparatus for recording telephone conversations users. Walker et al also teach on column 6 line 44-67 the first party (claimed "first telecommunication device" which includes item 13 and item 12 of Fig. 1A) sends a message requesting authorization to the second telecommunication device for the recording. The second telecommunication device responds authorization to the first telecommunication device by using the touch tone keys or with a voice command.

Regarding "the first and second telecommunications devices each comprise a speaker and a microphone", Walker teach on column 10 line 36-38 a touch tone telephone.

Regarding claim 2, it is inherent that when the authorization responded by the second telecommunication device is negative the recording is prohibited.

Regarding claim 3, Walker et al teach on column 6 line 63-65 the requesting message is a voice message.

Regarding claims 6, 10 and 15, the system of Walker et al must advise the user of the first telecommunication device whether the authorization request is granted or not.

Art Unit: 2645

Regarding claim 7, regarding “said telephone conversation.....additional telecommunication device”. Walker et al teach on column 5 line 23-25 embodiment for recording conference call.

Regarding claim 9, Walker et al teach on column 6 line 54-57, voice recognition processor.

Regarding claims 11 and 16, Walker et al teach on column 6 line 44-67 the authorization from the second party is received (reads on the claimed “stored”) by the audio vault (the claimed “device”).

Regarding claim 12, Walker et al teach on column 12 line 50-54 the system could use triangulating cellular phone signals. It is obvious that the telephone devices taught by Walker et al include cellular telephones (the claimed “mobile telephone”).

Regarding 13, Walker et al teach on column 6 line 57-67, the audio vault (the claimed “telecommunication device”) automatically responds to the authorization request by sending a query to the second party.

Art Unit: 2645

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US: 6529602), and in view of Kim (US: 6278884) and Lee (US: 6526287).

All rejections as stated in claim 1 above apply.

Regarding the recording being performed under control of said first telecommunication device, Walker et al teach on column 7 line 1-2 the audio vault (the claimed “first telecommunication device” controls the recording).

Walker et al failed to teach “performing said recording, by circuit integrated in the first telecommunications device”, Kim teaches on items 11, 44, 54, 22 Fig. 2 integrated circuitry for performing the recording.

Walker et al failed to teach “performing said recording, by an accessory attached to the first telecommunication device”, Lee teaches on Fig. 4, column 1 line 64-67 a cellular phone with an attached accessory (“MP3 player” of Lee) to record sound from a mike and speaker mixer via a call processing part.

It would have been obvious to one skilled at the time the invention was made to modify Walker et al to have “performing said recording, by circuit integrated in the first

Art Unit: 2645

telecommunications device or by an accessory attached to the first telecommunication device” as taught by Kim and Lee such that the modified system of Walker et al would be able to support the recording either by integrated circuit or by an accessory to the system users.

*Response to Arguments*

4. Applicant's arguments filed on 7/3/03 have been fully considered but they are not persuasive.
  - i) Applicant argues, on page 9, regarding referenced prior art (Walker et al) relative to the Applicant's specification. Walker et al teach “party 1” and “party 2” on Fig. 1A. However, Walker et al also teach telephone connections between Party 1, Party 2, and Audio Vault. It is obvious that “Party 1” and “Party 2” on Fig 1A not only represent two communication parties but also represent two communication devices as Applicant claimed.
  - ii) Applicant argues, on page 10, regarding claimed “telecommunication device” in claim 1. Walker et al teach on Fig. 1A the Audio Vault links two parties by telephone connections. The Audio Vault can be physically located or attached to the first communication device by a telephone connection while connecting with the second device by another telephone connection.

Art Unit: 2645

- iii) Applicant argues, on page 10, regarding "sending authorization". Walker et al teach on column 6 line 44-67 how the request for authorization of recording to the other party is performed.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The



Art Unit: 2645

examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any inquiry of a general nature or relating to the status of this application or proceeding should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

**Or faxed to TC2600's Customer Service FAX Number 703-872-9314.**

Patent Examiner

Art Unit 2645

Ming Chow



FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

